

ESTTA Tracking number: **ESTTA1088154**

Filing date: **10/12/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Date	10/12/2020
Attachments	Pet. Open. Br. FINAL 101220.pdf(2612448 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Verne Andrusiek,

Petitioner,

v.

Cosmic Crusaders, LLC,

Respondent.

Cancellation No. 92064830

PETITIONER'S OPENING BRIEF ON  
THE CASE

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## I. INTRODUCTION

The evidence of record makes clear that Registration No. 4,782,920 for the CAPTAIN CANNABIS word mark used on comic books (the “Registration”) should be cancelled for at least four independent reasons:

**First**, Petitioner Verne Andrusiek (“Petitioner”) began using the CAPTAIN CANNABIS trademark in commerce in the United States on comic books and related goods and services long before Cosmic Crusaders, LLC (“Respondent”) even claims to have done so. The marks at issue are the same, the goods at issue are the same (and closely related), and neither party truly disputes likelihood of confusion. But Petitioner has priority of rights over Respondent through prior use in commerce. Thus, the Registration should be cancelled for likelihood of confusion with Petitioner’s CAPTAIN CANNABIS mark under 15 U.S.C. § 1052(d).

**Second**, the claimed CAPTAIN CANNABIS mark, as used by Respondent, fails to function as a trademark. At most, Respondent (occasionally) used the words CAPTAIN CANNABIS in the title of a single comic book issue. Words used in such a manner fail to function as a trademark. *See Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d 1375, (Fed. Cir. 2002). Accordingly, the Registration should be cancelled for failure to function as a trademark under *Herbko* and similar precedent.

**Third**, Respondent has not used the CAPTAIN CANNABIS trademark at all. Respondent is a fictional entity that only existed for a year and a half, was dissolved over five years ago, and has no capacity to carry on any use of the CAPTAIN CANNABIS trademark. Respondent’s purported President, Lewis Davidson, testified that he used the CAPTAIN CANNABIS trademark in his

personal capacity and continues to claim the he personally uses and owns the CAPTAIN CANNABIS trademark. There is no evidence of any transfer of rights or goodwill between Mr. Davidson and Respondent. Accordingly, the Registration should be cancelled for lack of trademark use by Respondent, and because Respondent was never the true owner of the CAPTAIN CANNABIS mark.

**Lastly**, Respondent and Lewis Davidson committed fraud on the PTO. Respondent and Mr. Davidson swore that no other entity had the right to use the CAPTAIN CANNABIS trademark in commerce on comic books, despite actual knowledge of Petitioner's prior use of and rights in the CAPTAIN CANNABIS trademark. Indeed, Mr. Davidson admitted in writing that it was his knowledge of Petitioner's prior use that spurred him to improperly obtain the Registration. Respondent also falsely claimed that its substitute specimen of use depicted "another issue in Applicant's serialized comic book series under the mark CAPTAIN CANNABIS." This was a lie. In fact, Respondent never published a series of comic books. At most, Respondent published a single comic book issue, and occasionally used the words CAPTAIN CANNABIS as part of an alternative title for that single issue. These misrepresentations were made knowingly, and with the intent to obtain a registration to which Respondent had no right. Accordingly, the Registration should be cancelled for fraud on the PTO.

## **II. EVIDENCE OF RECORD**

The evidence of record consists of Registration No. 4,782,920 and the application file thereof, the Affidavit of Tom Edgar and Annexures thereto (11 TTABVUE 2-5), The Affidavit of Laverne John Andrusiek and Annexures thereto (11 TTABVUE 6-95), the Declaration of Lewis Davidson and

Exhibits thereto (17 TTABVUE 2-8), The Declaration of Alex Wadsworth and Exhibit thereto (18 TTABVUE 2-3), Petitioner's Notice of Reliance and Exhibits (12 TTABVUE 2-55), Petitioner's Rebuttal Notice of Reliance and Exhibits thereto (37 TTABVUE 2-18), the Corrected Rebuttal Declaration of Verne Andrusiek and Exhibits thereto (39 TTABVUE 2-142), and the Corrected Rebuttal Declaration of Michael P. Matesky, II and Exhibits thereto (39 TTABVUE 143-49).

### **III. RELEVANT FACTUAL BACKGROUND**

As described in detail below, the evidence of record shows that Petitioner has used the CAPTAIN CANNABIS trademark in commerce in the U.S.—on comic books and related goods and services—for decades before Respondent even claims to have used the CAPTAIN CANNABIS trademark. When Respondent's purported President Lewis Davidson learned of Petitioner's prior use of and rights to the CAPTAIN CANNABIS trademark, Mr. Davidson applied to register the CAPTAIN CANNABIS trademark for comic books, as part of a scheme to extort<sup>1</sup> licensing royalties from Petitioner based on Petitioner's pre-existing business.

Respondent obtained the Registration on the basis of knowingly false statements made to the PTO. Mr. Davidson then threatened to shut down Petitioner's longstanding prior use of the CAPTAIN CANNABIS mark if Petitioner did not agree to pay licensing fees within three days. When Petitioner refused to accede to Respondent's scheme, Respondent in fact sent demand letters to multiple platforms shutting down Petitioner's listings for CAPTAIN CANNABIS-branded goods. Petitioner filed this petition to vindicate his prior rights and cancel Respondent's wrongfully-obtained Registration.

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<sup>1</sup> Petitioner uses the word "extort" herein in the colloquial sense, and is not necessarily referring to the criminal extortion law of any particular jurisdiction.



**A. Petitioner's Prior Use of the CAPTAIN CANNABIS Trademark**

Petitioner Laverne Andrusiek (p/k/a Verne Andru) is a veteran comic book artist, illustrator, and filmmaker. Andrusiek Aff. ¶ 2, 11 TTABVUE 6; Andrusiek Decl. ¶ 4, 39 TTABVUE 2. Petitioner began using the CAPTAIN CANNABIS trademark in commerce on comic books in the 1970s. Andrusiek Aff. ¶ 2, Annxs. 14-15, 11 TTABVUE 6, 14-16; Andrusiek Decl. ¶¶ 6-7, 9-10, Exs. 1-2, 39 TTABVUE 2-3, 15-21. More specifically, he began distributing comic books bearing the CAPTAIN CANNABIS mark to one or more U.S. residents from his home in Canada as early as 1978. Andrusiek Decl. ¶ 11, 39 TTABVUE 2.

Petitioner's CAPTAIN CANNABIS works feature the story of Halburt "Hal" Lighter, who transforms into the superhero CAPTAIN CANNABIS. Andrusiek Aff. ¶ 12, Annx. 33, 11 TTABVUE 60; Andrusiek Decl. ¶¶ 9-10, 19, Exs. 1-2, Ex. 5 p.3, Ex. 6 p. 4, Ex. 7. pp.1, 4, 39 TTABVUE 3, 5, 17, 20, 29, 34, 39, 42. Petitioner uses the CAPTAIN CANNABIS mark as both the name of the superhero character in his story, and the title of the series of comic books and other works embodying that story. Andrusiek Aff. ¶ 2, 11 TTABVUE 6; Andrusiek Decl. ¶ 2, 39 TTABVUE 3.

Since he began using the CAPTAIN CANNABIS mark on comic books in the 1970s, Petitioner has continued to develop his CAPTAIN CANNABIS story, including for use in a feature-length motion picture. Andrusiek Aff. ¶¶ 2, 27, 11 TTABVUE 6, 11; Andrusiek Decl. ¶ 53, 39 TTABVUE 12. However, the legal and political situation regarding cannabis—namely, the "War on Drugs"—inhibited Petitioner's ability to commercially develop the market for his CAPTAIN CANNABIS works. Around the turn of the 21<sup>st</sup> century, the tide began to turn with regard to public perception of cannabis. Andrusiek Aff. ¶ 18, 11 TTABVUE 9.

Petitioner promoted his CAPTAIN CANNABIS story at the National Association of Television Program Executives (NATPE) in New Orleans, Louisiana in 1999. Andrusiek Aff. ¶ 3, Annx. 17, 11 TTABVUE 6. Petitioner registered a CAPTAIN CANNABIS screenplay, based on the original story originally portrayed in his 1970s comic book series, with the Writers Guild of America in 2005. Andrusiek Aff. ¶ 5, Annx. 20, 11 TTABVUE 7, 26. Petitioner submitted multiple screenplay versions of his CAPTAIN CANNABIS story to the American Zoetrope workshop from 2011 to 2014. Edgar Aff. ¶¶ 2-3, Annx. 1, Andrusiek Aff. ¶ 16, 11 TTABVUE 2, 4, 9.

In 1999, Petitioner registered the CAPTAINCANNABIS.COM domain name and began using his CAPTAIN CANNABIS trademark on the website available at CAPTAINCANNABIS.COM (the “CAPTAIN CANNABIS Website”) to promote his CAPTAIN CANNABIS brand, character, story, comic books, and related products. Andrusiek Aff. ¶ 4, 11 TTABVUE 7; Andrusiek Decl. ¶ 13, 39 TTABVUE 4. Petitioner has prominently displayed his CAPTAIN CANNABIS trademark on his CAPTAIN CANNABIS Website since 1999. Andrusiek Aff. ¶ 4, 11 TTABVUE 7; Andrusiek Decl. ¶¶ 15-17, Exs. 3-4, 39 TTABVUE 4-5, 22-25. Petitioner sells his CAPTAIN CANNABIS comic books, DVDs, and related products to U.S. residents through his CAPTAIN CANNABIS Website. Andrusiek Aff. ¶ 4, Annx. 19, 11 TTABVUE 7, 24; Andrusiek Decl. ¶¶ 5, 14-15, 52, Ex. 3, 39 TTABVUE 2, 4, 6-8, 11-12. The majority of visitors to Petitioner’s CAPTAIN CANNABIS website are U.S. residents. *Id.* ¶¶ 14, 25, 39 TTABVUE 4, 6.

In 2006, Petitioner published his 420/CAPTAIN CANNABIS comic book issue, which is a continuation of the CAPTAIN CANNABIS story and series that Petitioner first began publishing in the 1970s. Andrusiek Aff. ¶ 6, 11 TTABVUE 7; Andrusiek Decl. ¶¶ 18-19, 39 TTABVUE 5. The 420/CAPTAIN CANNABIS comic book issue bears the CAPTAIN CANNABIS trademark on the

back cover and the editorial page. Andrusiek Aff. Annx. 22, 11 TTABVUE 30-31; Andrusiek Decl. ¶¶ 18, 21, Ex. 5 pp. 2-3, 39 TTABVUE 5, 28-29. Petitioner began selling and shipping physical copies of his 420/CAPTAIN CANNABIS comic book issue to U.S. residents, through his CAPTAIN CANNABIS Website and the Amazon sales platform, in 2006. Andrusiek Aff. ¶ 7, Annxs. 23-24, 11 TTABVUE 7, 33-36; Andrusiek Decl. ¶¶ 22-24, 52, 39 TTABVUE 6, 12.

For example, in 2006, Petitioner began shipping physical copies of his 420/CAPTAIN CANNABIS comic book issue to Amazon warehouses in Kentucky for distribution to U.S. customers who purchases the issue through the Amazon sales platform. Andrusiek Aff. ¶ 7, Annx. 24, 11 TTABVUE 7, 35-36; Andrusiek Decl. ¶¶ 24, 39 TTABVUE 7. Petitioner also shipped a physical copy of his 420/CAPTAIN CANNABIS to a customer in Hollywood, Florida, who was the first customer to send payment for a 420/CAPTAIN CANNABIS issue purchased through Petitioner's website. Andrusiek Aff. ¶ 8, Annx. 25 p.33, 11 TTABVUE 7, 38 ("Because you are the first to send in payment, I've included a special bonus as our way of saying 'thank you.'").

In 2007, Petitioner began distributing electronic versions of his 420/CAPTAIN CANNABIS comic book issue as well as comic "samplers" through his CAPTAIN CANNABIS Website, including to U.S. residents. Andrusiek Decl. ¶¶ 25-32, 39 TTABVUE 6-7. The sampler version Petitioner began distributing on August 10, 2007 states "OKee.comX, 420 and Captain Cannabis are trademarks of Verne Andru." Andrusiek Decl. ¶ 27, Ex. 6 p.1, 39 TTABVUE 7, 31. This and later sampler versions distributed by Petitioner also bear the CAPTAIN CANNABIS trademark on pages, including the back cover of the 420/CAPTAIN CANNABIS comic book issue, that explain the backstory of the CAPTAIN CANNABIS character. Andrusiek Decl. ¶¶ 27-30, Ex. 6, p. 7, Ex. 8 pp. 24, 26, Ex. 9 pp. 23, 25, 39 TTABVUE 7, 37, 70-71, 96, 98. The samplers Petitioner began

distributing on April 7, 2009 prominently displayed the CAPTAIN CANNABIS trademark with the “TM” designation on the first page of the sampler, as well as on order forms by which customers could purchase Petitioner’s CAPTAIN CANNABIS branded comic books and other products. Andrusiek Decl. ¶¶ 27-31, Ex. 7 pp.1, 7, Ex. 8 pp. 1-2, Ex. 9 p.1, 39 TTABVUE 7, 39, 45, 47-48, 74.

In 2007, Petitioner also began publishing, selling, and distributing CAPTAIN CANNABIS “extras” DVDs to U.S. residents, via the CAPTAIN CANNABIS Website, under the CAPTAIN CANNABIS trademark. These DVDs included multiple works, including the “samplers” discussed above. Andrusiek Decl. ¶¶ 33-34, 50, Ex. 20, 39 TTABVUE 7-8, 12, 123. The DVDs Petitioner began distributing on February 23, 2007 bore the CAPTAIN CANNABIS trademark on the back cover of the DVD packaging. Andrusiek Decl. ¶¶ 35, 50, Ex. 10 p. 1, 39 TTABVUE 8, 12, 100.

In 2009, Petitioner also began publishing and distributing CAPTAIN CANNABIS “animatics.” An animatic is an audiovisual work pairing sequential still comic book images with an audio soundtrack. Andrusiek Decl. ¶ 36, 38, 39 TTABVUE 8. Petitioner began publishing CAPTAIN CANNABIS animatics and other audiovisual works globally and to U.S. residents via the YouTube video platform in 2009. Andrusiek Decl. ¶ 36, 38, 39 TTABVUE 8. The animatics and other audiovisual works Petitioner published via the YouTube video platform prominently featured Petitioner’s CAPTAIN CANNABIS trademark. Andrusiek Decl. ¶ 38-40, Exs. 13-14, 39 TTABVUE 8, 102-04.

In 2009, Petitioner began publishing, selling, and distributing DVDs incorporating his CAPTAIN CANNABIS animatics. Andrusiek Decl. ¶¶ 36, 39 TTABVUE 8. The labels and external packaging for the animatic DVDs Petitioner began distributing on December 30, 2009

prominently featured the CAPTAIN CANNABIS trademark with the “TM” designation. Andrusiek Decl. ¶¶ 37, Exs. 11-12, 39 TTABVUE 8, 102-04.

In 2009, in addition to the order forms distributed with “samplers” described above, Petitioner began distributing order forms prominently bearing the CAPTAIN CANNABIS trademark with the “TM” designation at in-person events and to all customers who purchased comic books, DVDs, or other products through his CAPTAIN CANNABIS Website. Andrusiek Decl. ¶¶ 41-42, 47, 51-52, Exs. 15, 19, 39 TTABVUE 9, 11-12, 111, 120. For example, on April 6, 2009, Petitioner shipped an order form prominently displaying the CAPTAIN CANNABIS trademark with the “TM” designation to a customer in Brooklyn, NY, who had purchased a 420/CAPTAIN CANNABIS comic book issue and extras DVD through the CAPTAIN CANNABIS Website. Andrusiek Decl. ¶ 51, Exs. 15, 21 p.5 (Canada Post receipt), 39 TTABVUE 12, 111, 129.

In 2010, Petitioner created CAPTAIN CANNABIS social media profiles on MySpace and Facebook social media platforms, to promote his CAPTAIN CANNABIS comic books, character, story, DVDs, and other products. These profiles have always prominently featured the CAPTAIN CANNABIS trademark in the profile name and otherwise. Andrusiek Decl. ¶¶ 43-44, Exs. 16-17, 39 TTABVUE 9-10, 113-16.

Since 2007, Petitioner has attended multiple in-person events in the United States at which he used his CAPTAIN CANNABIS trademark while selling and promoting his CAPTAIN CANNABIS comic books, character, story, and related goods. Andrusiek Decl. ¶ 8, 41, 39 TTABVUE 3, 9. In 2007, Petitioner attended both Hempfest and Emerald City Comic Convention in Seattle, Washington and promoted and sold his CAPTAIN CANNABIS comic books, DVDs, and related goods. Andrusiek Aff. ¶ 5, 11 TTABVUE 8-9; Andrusiek Decl. ¶¶ 45-46, 39 TTABVUE 10-11. While

promoting and selling his CAPTAIN CANNABIS goods at Hempfest, Petitioner wore a t-shirt and hat displaying his CAPTAIN CANNABIS trademark. Andrusiek Aff. ¶ 15, 11 TTABVUE 8-9; Andrusiek Decl. ¶ 46, Ex. 18, 39 TTABVUE 10-11, 118. In 2013, Petitioner attended the APE comic books convention in San Francisco, California to promote and sell his CAPTAIN CANNABIS character, story, comic books, DVDs and related goods. Andrusiek Aff. ¶ 15, 11 TTABVUE 8-9; Andrusiek Decl. ¶ 47, 39 TTABVUE 11. He sold DVDs in packaging prominently displaying his CAPTAIN CANNABIS trademark with the “TM” designation and distributed a brochure and order form also displaying his CAPTAIN CANNABIS trademark with the “TM” designation. Andrusiek Decl. ¶¶ 37, 47, Exs. 11, 19, 39 TTABVUE 8, 11, 102-3, 105, 120.

Petitioner has continued to develop his CAPTAIN CANNABIS story, character, and works, and to offer, advertise, sell, and distribute his CAPTAIN CANNABIS comic books, DVDs, and related products to U.S. residents since the dates described above. Andrusiek Aff. ¶¶ 2, 4, 16-17, 27, Annxs. 16, 41-42, 11 TTABVUE 6-7, 9, 11, 24, 83, 85; Andrusiek Decl. ¶¶ 5-6, 8, 22-23, 31, 34, 38, 52-53, Exs. 3, 16-17, 39 TTABVUE 2-4, 6-8, 12, 23, 113-14, 116.

Petitioner’s longstanding use and promotion of the CAPTAIN CANNABIS mark in the United States have resulted in substantial media attention and notoriety, within the cannabis-oriented counterculture and otherwise. Andrusiek Aff. ¶¶ 8-12, Annxs. 27-33, 11 TTABVUE 7-8, 48-60; Pet. Not. Reliance ¶¶ 1-3, Annxs. 2-4, 12 TTABVUE 2-3, 8, 10-11, 15. Numerous magazines, radio stations, and podcasts have featured Petitioner as the creator of the CAPTAIN CANNABIS character and comic books series. *Id.* This includes media in Respondent’s local area. For example, Petitioner conducted an interview regarding his CAPTAIN CANNABIS comic books with Florida-based podcast *Q’s House* in 2007. Andrusiek Aff. ¶ 9, Annxs. 27-28, 11 TTABVUE 7, 48-50.

Petitioner and his CAPTAIN CANNABIS comic books were featured in 2007 issue of the highly-influential *High Times* magazine. Andrusiek Aff. ¶ 10, Annx. 29, 11 TTABVUE 8, 52. Petitioner and his CAPTAIN CANNABIS comic books were discussed in a cover-story of a 2011 issue of *Culture* magazine (a publication with a 500,000 copy monthly circulation). Andrusiek Aff. ¶ 12, Annxs. 31-33, 11 TTABVUE 8, 56-60. *Culture* magazine also published an article regarding the release of Petitioner's *CAPTAIN CANNABIS 40<sup>th</sup> Anniversary* comic book issue. Pet. Not. Reliance ¶ 1, Annx. 2, 12 TTABVUE 2, 8.

**B. Respondent's Claimed Junior Use of the CAPTAIN CANNABIS Trademark**

Respondent Cosmic Crusaders, LLC was a Florida LLC formed on March 19, 2014 and dissolved on September 25, 2015. Pet. Not. Reliance ¶ 10, Annx. 11, 12 TTABVUE 5, 51; Pet. Rebut. Not. Reliance ¶ 1, Ex. A p. 2, 37 TTABVUE 2, 7; Matesky Decl. ¶¶ 4-5, Exs. A-B, 39 TTABVUE 144-45, 147, 149. Although Respondent was dissolved five years go (i.e., Respondent no longer exists), Lewis Davidson claims he is the "President and sole owner" of Respondent. Davidson Decl., ¶ 1, 17 TTABVUE 2.

Mr. Davidson filed an "intent to use" application to register the CAPTAIN CANNABIS mark for comic books in Respondent's name on April 2, 2014. TEAS Plus New Application p. 1.<sup>2</sup> Mr. Davidson subsequently filed a statement of use on December 29, 2014, claiming that he began using the CAPTAIN CANNABIS mark on comic books in commerce on October 2, 2014. Statement of Use p. 1. Nonetheless, Mr. Davidson now claims that he "sold some copies of [his] 'Captain Cannabis' comic books personally in 2013." Davidson Decl., ¶ 13, 17 TTABVUE 2. There is no

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<sup>2</sup> For documents in the Registration's application file that are automatically of record pursuant to 37 C.F.R. § 2.122, petitioner refers to such documents as titled in the TSDR system, without TTABVUE citation.

documentary evidence in the record supporting this claim. To the contrary, the partial comic book that Respondent produced in discovery as well as the comic book pages that Petitioner independently obtained via the Amazon kindle platform display a copyright date of 2014. Andrusiek Decl. ¶¶ 54-56, Ex. 22 p.4, Ex. 23 p. 5, 39 TTABVUE 12-13, 132, 139. The only receipts provided by Mr. Davidson show transactions in 2014. This documentary evidence is consistent with Mr. Davidson's original claimed first use date in 2014. Davidson Decl., ¶ 15-16, 19, Exs. 1-1, 17 TTABVUE 3-4, 6-8; TEAS Plus New Application p.1.

Mr. Davidson also claims that he used *Captain Cannabis and the Cosmic Crusaders* as the title of his comic book. Davidson Decl. ¶ 4, 17 TTABVUE 4. However, the documentary evidence shows that Mr. Davidson's comic book was titled *The Cosmic Crusaders – "Reboot"* or some variation thereof. That is the title shown on the specimen of use originally submitted by Respondent, and on the cover of the comic book Petitioner obtained via the Amazon Kindle platform. Dec. 29, 2014 Stmt. of Use pp. 2-3, Dec. 29, 2014 Specimen pp.1-2; Andrusiek Decl. ¶ 56, Ex. 23 pp.1-2, 39 TTABVUE 13, 135-36. The Kindle listing identifies the title as *Reboot (The Cosmic Crusaders Book 1)*. Andrusiek Decl. ¶ 56, Ex. 23 pp.1, 39 TTABVUE 13, 135. *The Cosmic Crusaders – "Reboot"* is the title shown on the cover image Mr. Davidson made available through his LinkedIn page. Andrusiek Aff. ¶ 13, Annx. 35, 11 TTABVUE 8, 14. Even the title page of the partial comic book Respondent produced in discovery identifies the title as *The Cosmic Crusaders Issue #1 "Reboot."* Andrusiek Decl. ¶¶ 54-55, Ex. 22 p.4, 39 TTABVUE 13-14, 132.

Respondent never claimed that it used CAPTAIN CANNABIS in the title of any comic book until after the examining attorney refused Respondent's application. On February 6, 2015, the examining attorney rejected Respondent's application on the grounds that the claimed CAPTAIN



CANNABIS mark does not function as a trademark on the specimen submitted by Respondent. Office Action Outgoing (“Sections 1, 2, and 45 Refusal—Mark Does Not Function As A Trademark”). On May 27, 2015, Respondent submitted a substitute specimen showing the same comic book cover, but bearing the title *Captain Cannabis and the Cosmic Crusaders*. Respondent falsely identified this specimen as depicting “another issue in Applicant’s serialized comic book series under the mark CAPTAIN CANNABIS.” Resp. to Office Action pp. 1-2.

After Petitioner initiated this proceeding, Mr. Davidson claimed that he had used the *Captain Cannabis and the Cosmic Crusaders* title all along since 2013, but simply published some copies with the alternative *The Cosmic Crusaders Issue #1 “Reboot.”* title. Davidson Decl. ¶ 17, 17 TTABVUE 4. In other words, Mr. Davidson confirmed that his substitute specimen of use was not actually “another issue” in his “series,” as he claimed to the PTO, but simply an alternative cover/title for the same comic book issue. There is no evidence that Respondent ever produced, advertised, offered, sold, or distributed more than one comic book issue, under any title. The partial comic book that Respondent produced in discovery (bearing the *Captain Cannabis and the Cosmic Crusaders* title on the cover) is identical to the pages of the *The Cosmic Crusaders Issue #1 “Reboot”* comic book Petitioner obtained through the Amazon Kindle platform. Both versions identify their titles as *The Cosmic Crusaders Issue #1 “Reboot”* on the title page. The only difference is the title on the cover. Andrusiek Decl. ¶¶ 54-56, Exs. 22-23, 39 TTABVUE 12-13, 131-33, 136-39.

Although Mr. Davidson claims to have used the CAPTAIN CANNABIS trademark since before Respondent existed, and there is no record evidence that Mr. Davidson ever assigned, exclusively licensed, or otherwise transferred any trademark rights or goodwill to Respondent, nor is

there any evidence that Respondent used the CAPTAIN CANNABIS trademark in any capacity after its dissolution. To the contrary, Mr. Davidson continues to claim use and ownership of the CAPTAIN CANNABIS trademark rights in his individual capacity. More specifically, after Respondent's dissolution, Mr. Davidson applied for and obtained—in his personal capacity—Registration No. 5,315,072 for the CAPTAIN CANNABIS mark for t-shirts, hats, and entertainment services (including “videos featuring cannabis plans and products.”). Pet. Rebuttal Not. Reliance ¶ 2, Ex. B pp.1-2, 8, 37 TTABVUE 2-3, 10-11, 17.

**C. Respondent's Fraudulent Intent and Attempted Extortion of Petitioner**

On May 13, 2013, Petitioner contacted Lewis Davidson to inform him of Petitioner's prior use of and rights in the CAPTAIN CANNABIS trademark, and to demand that Mr. Davidson stop using the CAPTAIN CANNABIS trademark in connection with a video distributed under the title *The Captain Cannabis Show*. Andrusiek Aff. ¶ 21, 11 TTABVUE 10. Despite obtaining this actual knowledge of Petitioner's prior use of and rights in the CAPTAIN CANNABIS mark, and despite acknowledging that Petitioner had “spent a lot of time and money on [Petitioner's] project,” Mr. Davidson turned around and applied to register the CAPTAIN CANNABIS mark for “comic books” on April 2, 2014. Pet. Not. Reliance ¶¶ 5-6, Annx. 6, Ex. A at p.25, Annx. 7 at p.27, 12 TTABVUE 3-4, 26, 28.

Mr. Davidson later admitted that it was Petitioner's notice of rights in the CAPTAIN CANNABIS trademark that spurred Mr. Davidson to file his own trademark application, or, as he put it, to “buy the rights to the name with a registered Trademark.” *Id.* Mr. Davidson then issued an ultimatum to Petitioner: Petitioner must agree within three days to pay licensing royalties on Petitioner's “T-shirts, Comic Books, and even the cartoon movie...or simply have all of

[Petitioner's] stuff deleted.” *Id.* Petitioner did not agree to a licensing agreement with Respondent, and Respondent did in fact send infringement complaints to multiple distribution platforms, resulting in such platforms removing Petitioner's CAPTAIN CANNABIS products (at least temporarily). *Andrusiek Aff.* ¶¶ 7, 16, 11 *TTABVUE* 7, 9. Petitioner refused to accede to Respondent's scheme, and filed this Petition to vindicate his prior rights and cancel Respondent's wrongfully-obtained Registration.

#### **IV. LEGAL ARGUMENT AND AUTHORITY**

As discussed in detail below, the Board should cancel the Registration (1) based on a likelihood of confusion with Petitioner's previously-used CAPTAIN CANNABIS mark, (2) because the registered CAPTAIN CANNABIS mark fails to function as a trademark as used by Respondent, (3) because Respondent has not used and is not the owner of the CAPTAIN CANNABIS mark, and (4) because Respondent obtained the Registration by fraud on the PTO.

##### **A. The Registered CAPTAIN CANNABIS Mark is Likely to Cause Confusion with Petitioner's Previously Used CAPTAIN CANNABIS Mark**

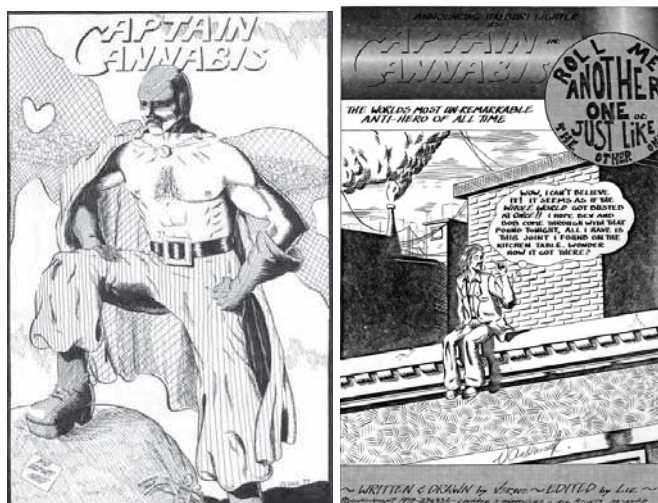
The Board should cancel the Registration because Petitioner began using the CAPTAIN CANNABIS trademark in commerce in the United States on comic books and related goods and services long before Respondent claims to have done so. A registration should be cancelled where the registered mark “so resembles...a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion, or to cause mistake, or to deceive.” Trademark Act § 2(d), 15 U.S.C. § 1052(d). To obtain cancellation under Section 2(d), Petitioner must prove both (1) priority, and (2) likelihood of confusion. *See id.*; *see generally* TBMP § 309.03(c)(2). The evidence shows

that Petitioner used his CAPTAIN CANNABIS trademark in commerce in the U.S. on comic books and related goods and services many years before Respondent ever claims to have done so, thereby establishing Petitioner's priority. With regard to likelihood of confusion, the marks and goods are identical, and both parties agree that a likelihood of confusion arises from both parties' use of the CAPTAIN CANNABIS mark. Thus, Petitioner has proven the two elements of its Section 2(d) claim, and the Board should cancel the Registration.

### **1. Petitioner Has Priority of Rights**

The evidence shows that Petitioner began using the CAPTAIN CANNABIS trademark in commerce in the U.S. on comic books and related goods and services decades before Respondent even claims to have done so. A petitioner may prove priority by proving prior trademark (or analogous) use of the CAPTAIN CANNABIS mark in the United States. Such use need not be continuous. Rather the question is "whether the mark or trade name has been 'previously used in the United States by another and not abandoned.'" *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1607 (TTAB 2018). It is Petitioner's burden to prove use in the United States prior to Respondent's first use date. If Respondent alleges abandonment subsequent to that date, it is Respondent's burden to prove the alleged abandonment and that Petitioner did not resume use prior to Respondent's first use. *See id.* at 1605. In determining priority, the Board must review the evidence as a whole, "as if each piece of evidence were part of a puzzle [to be] fitted together," to determine if Petitioner has established prior use by a preponderance of the evidence. *Id.* at 1609 (quoting *West Fla. Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 1125-26, 31 U.S.P.Q.2d 1660, 1663 (Fed. Cir. 1994)). Because the evidence shows that Petitioner has used the CAPTAIN CANNABIS mark in the U.S. on

**In the 1970s**, Petitioner began distributing comic books to U.S. residents bearing the CAPTAIN CANNABIS trademark. Petitioner published multiple issues of these comic books, which prominently displayed the CAPTAIN CANNABIS mark as shown below:



Andrusiek Decl. ¶ 9-10, Exs. 1-2, 39 TTABVUE 3, 16-17, 19-20. This evidence alone, showing prominent use of the CAPTAIN CANNABIS mark on multiple comic book issues, establishes Petitioner’s priority. *See In re Arnold*, 105 USPQ2d 1953, 1956 (TTAB 2013) (“[A] title used on a series of works is, indeed, registrable.”).

In 1999, Petitioner began promoting his CAPTAIN CANNABIS comic books and related products to U.S. residents via the CAPTAIN CANNABIS Website available at CAPTAINCANNABIS.COM. At the outset in 1999, the CAPTAIN CANNABIS Website displayed petitioner’s artwork and the CAPTAIN CANNABIS trademark, with a “TM” designation, in the following form:



Andrusiek Decl. ¶ 17, 39 TTABVUE 5-6.

**At all times since 1999**, the CAPTAIN CANNABIS Website has prominently displayed the CAPTAIN CANNABIS trademark in one or more of the following forms:



Andrusiek Decl., ¶ 16, Ex. 4, 39 TTABVUE 4, 25.

Such use of the CAPTAIN CANNABIS mark on the CAPTAIN CANNABIS Website, in promotion of Petitioner’s comic books, character, story, and related products, constitutes, at the least, “analogous use” that is sufficient to establish Petitioner’s priority. *See Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065 (Fed. Cir. 1989)(Prior “analogous” use, as in advertising and promotional materials, can defeat a registration under Section 2(d)); *Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 20, 86 U.S.P.Q.2d 1527, (D.C. Cir. 2008) (“An opposer may rely on myriad forms of activity besides sales themselves, including, among others, regular business contacts, after-sales services, advertising of various forms, and marketing...Even marketing of a trademarked product before the product is ready for sale has the potential to defeat a

rival's registration.”) (internal citations omitted). Petitioner’s extensive promotion and advertising under the CAPTAIN CANNABIS brand has, in fact, resulted in significant notoriety of Petitioner’s CAPTAIN CANNABIS mark and association with Petitioner’s comic books, long prior to Respondent’s claimed first use. *See supra* at pp. 9-10.

In the **the mid-to-late 2000s**, Petitioner began offering, advertising, selling, and distributing his CAPTAIN CANNABIS comic books, DVDs, and related audiovisual works to U.S. residents through sales made on the CAPTAIN CANNABIS Website as well as third-party sales and distribution platforms.

In **2006 and 2007**, Petitioner began selling and distributing physical comic books and DVDs featuring his comic artwork, purchased through his CAPTAIN CANNABIS Website and through the Amazon sales platform, to U.S. residents. These works included his 420/CAPTAIN CANNABIS comic book issue—a continuation of his CAPTAIN CANNABIS series—as well as comic artwork incorporated in DVDs. *See* Andrusiek Aff. ¶¶ 4, 8, Annxs. 19, 25 p. 33, 11 TTABVUE 7, 24, 38; Andrusiek Decl. ¶¶ 5, 14-15, 22, 25-32, 52, Exs. 3, 6-9, 39 TTABVUE 2, 4, 6-8, 11-12, 30-98.

When Petitioner began providing such sales, ordering, and distribution services through the CAPTAIN CANNABIS Website, his use of the CAPTAIN CANNABIS mark on the CAPTAIN CANNABIS website was use of the mark in connection with online retail store services. *See* Trademark Act § 45(2), 15 U.S.C. § 1127(2) (“[A] mark shall be deemed to be in use in commerce... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.”). Such use also constitutes use of the CAPTAIN CANNABIS trademark on the comic books, DVDs, and other products that Petitioner sold through the CAPTAIN



CANNABIS Website. *See Marketquest Grp., Inc. v. BIC Corp.*, 316 F.Supp.3d 1234, 1287-88 (S.D. Cal. 2018) (Use of mark on website where purchasers can order goods constitutes use of mark on goods).

In 2009, Petitioner began distributing comic book artwork samplers to U.S. residents prominently featuring the CAPTAIN CANNABIS trademark with “TM” designation on the initial page, as shown below:



Andrusiek Decl. ¶ 28, Ex. 7 p.1, 39 TTABVUE 7, 39.







Also in 2009, Petitioner began distributing DVDs featuring his comic book artwork to U.S. residents in packaging and labels prominently featuring the CAPTAIN CANNABIS trademark with the “TM” designation. Andrusiek Decl. ¶ 36-37, Exs. 11-12, 39 TTABVUE 8, 102-05. An example is shown below:



Andrusiek Decl. ¶ 37, Ex. 12, 39 TTABVue 8, 105.

Such use of the CAPTAIN CANNABIS mark on Petitioner’s comics, labelling, and packaging constitutes trademark use in commerce. *See* Trademark Act § 45(1), 15 U.S.C. § 1127(1) (“[A] mark shall be deemed to be in use in commerce...on goods when...it is placed in any manner on the goods or their containers...or on the tags or labels affixed thereto...and the goods are sold or transported in commerce.”).

Since at least 2009, Petitioner has shipped order forms prominently displaying the CAPTAIN CANNABIS trademark with the “TM” designation to all customers—including U.S. residents—who purchase products through the CAPTAIN CANNABIS Website, as shown below:

ORDER FORM - PRICES INCLUDE SHIPPING TO U.S. & CANADA		PRICE	QTY	TOTAL
	<b>420 #1</b> - The first in the comic book series comprising the Captain Cannabis origin story. 24 pages (including cover) of full colour 420 fun. Includes first 7, 420 film sequences in high resolution colour, <i>The Story Behind The Story</i> and more. Start your collection today.	\$10.95		
	<b>420 #1 Extra DVD</b> - [NTSC] The perfect companion to the 420 comic book. All scenes from the first book plus the Squeegie Cleaners playing <i>I'm gonna rock a stupid!</i> 420 screenplay, interview's with creator Verne Andrusiek plus the animation version of the <i>Art of Verne</i> . Almost 4 gigs of 420 fun!	\$10.95		
	<b>420 Screenplay</b> - For 420-aholics. If you're like Marion and can't wait to find out what's happening next, now's your chance to find out. The complete final <b>420 production screenplay</b> [Writers Guild of America # 046195] is now available. 108 pages, 6 5/8" x 10 1/8" - colour/B&W mix.	\$11.95		
	<b>Art Of Verne</b> - Handsome booklet brings together the most influential pieces from Verne's comic, illustration and animation portfolios. Reproduces a collection of his more popular published works along pieces never seen before. 16 pages - B&W. Overall size - 8.5" x 5.5".	\$4.50		
	<b>Art Of Verne Underground Collection</b> - Material long out of print including five stories from Jim McPherson's <i>Phantasma Mythos</i> and his first collaborations with DC/Marvel artist George Freeman. A <b>420</b> sampler rounds out this 92 pages jam-packed with excitement. 6 5/8" x 10 1/8" - colour/B&W mix.	\$11.95		
	<b>The Circuit</b> - Limited Edition Art Print published from the painting used on <i>The Circuit</i> record jacket. Overall paper size - 19" x 25". 800 s/n prints. Printed on museum quality, acid free paper. Accompanied with certificate of authentication. [* s/n - Pencil signed and numbered.]	\$20.95		
<div>Print this page and send with your order.</div> <div> <div>ORDER TOTAL:</div> <div>ENCLOSE MONEY ORDER IN THIS AMOUNT</div> </div>				

NAME: \_\_\_\_\_  
EMAIL: \_\_\_\_\_  
ADDRESS: \_\_\_\_\_  
CITY: \_\_\_\_\_ STATE/PROV: \_\_\_\_\_ ZIP/POSTAL: \_\_\_\_\_

Allow 2 to 3 weeks for processing and delivery. All orders sent out in sturdy mailers. We will replace any order damaged in delivery upon return receipt of damaged goods. Shipping costs included in price for U.S. and Canadian orders. For all other destinations, email [contact@okee.com](mailto:contact@okee.com) for shipping costs before sending in this form. Send **international postal money orders** only made payable to **Verne Andrusiek**.  
Send a copy of this form along with payment to:

Contact us at:  
email: [contact@okee.com](mailto:contact@okee.com)  
www: [www.okee.com](http://www.okee.com)  
[www.CaptainCannabis.com](http://www.CaptainCannabis.com)  
[www.VerneAndrusiek.com](http://www.VerneAndrusiek.com)  
Petitioner Verne Andrusiek

oKee.comX  
518-1917 W. 4th Ave.  
Vancouver, BC  
Canada, V6J-1M7

Rev. 03/4/08. Valid until superseded.

*Captain Cannabis*

PRICE	QTY	TOTAL
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Andrusiek Decl. ¶¶ 41-42, 51, Ex. 15, 39 TTABVUE 9, 111; *see also Id.* ¶ 47, Ex. 19, 39 TTABVUE 11, 120. Distribution of an order form prominently displaying a mark, describing the products available, and providing a means for ordering such products, constitutes trademark use on such products. *See Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314 (E.D. Va. 1992).

In 2009 and 2010, Petitioner began distributing audiovisual works to U.S. residents under the CAPTAIN CANNABIS trademark via the YouTube video platform, as shown below:



Andrusiek Decl. ¶¶ 38-40, Exs. 13-14, 39 TTABVUE 8, 102-04. This constitutes use of the CAPTAIN CANNABIS trademark in commerce in connection with such audiovisual works. *See* TMEP § 904.03(e) (“An acceptable specimen might be a photograph or printout of a display screen projecting the identifying trademark for a computer program, or a photograph of a frame(s) of a movie or video bearing the mark.”); *cf. In re Sones*, 590 F.3d 1282, 1288 (Fed. Cir. 2009) (While the TMEP is not established law, it is instructive).

Each of the specific uses described above shows Petitioner’s prior use of the CAPTAIN CANNABIS trademark in the U.S., and Petitioner has continued to use the CAPTAIN CANNABIS trademark on comic books and related goods and services in the U.S. Andrusiek Aff. ¶¶ 2, 4, 16-17, 27, Annxs. 16, 41-42, 11 TTABVUE 6-7, 9, 11, 24, 83, 85; Andrusiek Decl. ¶¶ 5-6, 8, 22-23, 31, 34, 38, 52-53, Exs. 3, 16-17, 39 TTABVUE 2-4, 6-8, 12, 23, 113-14, 116. More specifically, the evidence clearly establishes that Petitioner has used the CAPTAIN CANNABIS trademark in commerce in the U.S. (1) on comic books since the **1970s**, (2) in online advertising for comic books and related retail services since **1999**, (3) in connection with online retail store services featuring comic books and related audiovisual works since **2006**, and (4) on DVDs and related audiovisual

works featuring Petitioner’s comic book artwork, and advertisements therefore, since at least the **2007-2009** time frame. When viewed as a whole, as puzzle pieces fitted together, Petitioner’s evidence establishes Petitioner’s prior use of the CAPTAIN CANNABIS starting in the 1970s, continuing through the 2000s, and to the present day. *See West Fla. Seafood*, 31 F.3d at 1125-26.

In contrast, Respondent’s earliest claimed first use date is **2013**.<sup>3</sup> In the absence of any evidence of earlier use, the earliest date upon which Respondent may rely is the filing date of its underlying application: April 2, 2014. *See* Trademark Act Section 7(c), 15 U.S.C. §1057(c); *see also Larami Corp. v. Talk to Me Programs, Inc.*, 36 U.S.P.Q.2d 1840 (TTAB 1995). Although witness testimony may be sufficient to establish a priority date, it “should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.” *Kemi Organics*, 126 USPQ2d at 1608 (quoting *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 U.S.P.Q.2d 1175, 1184 (TTAB 2017)). In this case, the only evidence supporting Respondent’s claimed first use date of 2013 is indefinite testimony that contradicts both Mr. Davidson’s prior claims and the documentary evidence.

Mr. Davidson now claims that he “sold some copies of [his] ‘Captain Cannabis’ comic books personally in 2013.” Davidson Decl. ¶ 13, 17 TTABVUE 2. Mr. Davidson’s testimony on this point is indefinite because it does not distinguish between books bearing the *The Cosmic Crusaders – “Reboot”* title (rejected by the examining attorney as a specimen of use) or the purported *Captain Cannabis and the Cosmic Crusaders* title. In any event, his new claim contradicts his prior

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<sup>3</sup> As discussed in Sections IV(B) and IV(C), *infra*, the evidence shows that Registrant did not actually use the CAPTAIN CANNABIS mark—as a trademark or otherwise—at all.

statement that he began using the CAPTAIN CANNABIS trademark on comic books on October 2, 2014 (December 29, 2014 Statement of Use), as well as the documentary evidence.

All the evidence of Respondent's comic books identify the copyright date as 2014, and the only receipts and invoices provided by Respondent are also from 2014. Andrusiek Decl. ¶¶ 54-56, Ex. 22 p.4, Ex. 23 p. 5, 39 TTABVUE 12-13, 132, 139; Davidson Decl. ¶ 15-16, Ex. 1, 17 TTABVUE 6-8. Thus, the evidence for Respondent's claimed 2013 first use date is "characterized by contradictions, inconsistencies, and indefiniteness," and should be rejected for that reason. *See Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (quoting *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945)).

Even if the Board were to credit Mr. Davidson's contradictory new claim that he began using the CAPTAIN CANNABIS trademark on comic books in 2013, that date is still many years after Petitioner began using the CAPTAIN CANNABIS mark on comic books and related goods and services. Thus, regardless of whether the Board credits Mr. Davidson's testimony, Petitioner has established that his CAPTAIN CANNABIS trademark was "previously used in the United States" long before Respondent's first use. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d); *Kemi Organics*, 126 USPQ2d at 1605 (The Board need not resolve ambiguity regarding Respondent's first use date where Petitioner established priority in either case).

## **2. Petitioner Has Proven Likelihood of Confusion**

The Board should find that a likelihood of confusion exists between Petitioner's CAPTAIN CANNABIS mark and Respondent's CAPTAIN CANNABIS mark because the parties do not genuinely contest likelihood of confusion. Where parties do not contest whether a likelihood of confusion exists, the Board need not resolve the issue. *See, e.g., Kemi Organics*, 126 USPQ2d at



1603, 1609. In this case, Respondent has claimed that Petitioner's use of the CAPTAIN CANNABIS mark on comic books and related goods creates a likelihood of confusion and constitutes trademark infringement. Andrusiek Aff. ¶¶ 7, 16, 11 TTABVUE 7, 9. Thus, there is no genuine dispute, and likelihood of confusion is sufficiently established.

In any event, Petitioner's and Respondent's CAPTAIN CANNABIS word marks are identical, and the goods at issue (comic books) are identical, which demonstrates a likelihood of confusion. *See, e.g., Kohler Co. v. Baldwin Hardware Corp.*, 82 U.S.P.Q.2d 1100, 1109 (TTAB 2007) ("The marks in this proceeding are identical in sound, appearance, meaning and commercial impression, both marks being DEVONSHIRE in standard character form. This factor heavily favors petitioner.") (citing *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005)).

Petitioner also uses the CAPTAIN CANNABIS mark on closely related goods and services, namely, DVDs and other audiovisual works featuring comic book artwork, and retail sales services featuring comic books, DVDs, and other audiovisual works featuring comic book artwork. *See, e.g., Research in Motion Ltd. v. Defining Presence Marketing Grp. Inc.*, 102 USPQ2d 1187, 1195 (TTAB 2012) ("[T]here is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion.") (quoting *In re Peebles, Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992)). The parties' simultaneous use of the CAPTAIN CANNABIS mark has, in fact led to cases of actual confusion between the parties. Andrusiek Aff. ¶¶ 22-24, Annxs. 46-47, 11 TTABVUE 10, 93, 95.

Thus, Petitioner has established both priority of rights and a likelihood of confusion, and the Registration should therefore be cancelled under Trademark Act § 2(d).

**B. The Registered “CAPTAIN CANNABIS” Mark Fails to Function as a Mark**

The Board should cancel the Registration under Trademark Act Sections 14(1) and 1,2 and 45, 15 U.S.C. §§1051, 1052, and 1127, because Respondent’s alleged CAPTAIN CANNABIS mark fails to function as a trademark. Cancellation is appropriate where the claimed mark fails to function as a trademark as used by the Respondent. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (Cancelling registration for “I ♥ DC” because it fails to function as a mark); *see also* TBMP § 309.03(c)(1)(Cancellation is appropriate where “the term for which registration...has been obtained has not been used as a trademark or service mark.”). This is true where the Respondent uses the alleged mark as the title of a single creative work. *See* TBMP § 309.03(c)(1)(Cancellation is appropriate where the alleged “mark is the title of a single creative work and not considered a trademark.”) (citing *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142-44 (TTAB 2011)). Because the evidence shows that Respondent has, at most, used the term CAPTAIN CANNABIS in the title of a single creative work, and not with any series of works, the Board should cancel the Registration for failure to function as a mark.

It is well-settled that titles of individual creative works cannot be protected as trademarks, because they do not function as trademarks. *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d 1375, (Fed. Cir. 2002) (“This court’s precedent also clearly holds that the title of a single book cannot serve as a source identifier.”) (collecting cases); *In re Posthuma*, 45 U.S.P.Q.2d 2011, 2013 (TTAB 1998) (“Through the years the Board has reiterated that titles of single works are not registrable as trademarks.”) (collecting cases). Rather, a term must be used to identify the source of a series of creative works to function as a trademark. *See Mattel Inc. v. Brainy Baby Co.*, 101



USPQ2d 1140, 1142-44 (TTAB 2011).

The evidence shows that, to the extent Respondent used the words CAPTAIN CANNABIS at all, Respondent used the claimed mark in the title of a single comic book. Petitioner requested that Respondent produce documents constituting and/or evidencing each of Respondent's alleged uses of the CAPTAIN CANNABIS mark on comic books. Pet. Not. Reliance ¶ 9, Annx. 10 at p. 43 (Request Nos. 2, 4), 12 TTABVUE 5-6, 44. In response, Respondent produced only a single, partial comic book bearing the title *Captain Cannabis and the Cosmic Crusaders* on the cover. Respondent has not produced in discovery nor entered into the record any evidence showing use of the term CAPTAIN CANNABIS as a source identifier for a series of creative works. Indeed, Registrant has not produced in discovery nor entered into the record any evidence that Registrant ever produced a series of comic books under any title. In short, the evidence of record demonstrates no use of the words CAPTAIN CANNABIS in connection with a series of comic books.

At most, even if the Board to credit Mr. Davidson's contradictory testimony, Respondent may have occasionally distributed a single comic book issue with alternative cover pages bearing alternative titles. This is what Lewis Davidson now claims (i.e., that he simply changed the title for distribution in some areas). Davidson Decl. ¶ 17, 17 TTABVUE 4. The documentary evidence of record also shows that Respondent's *The Cosmic Crusaders – "Reboot"* comic book and *Captain Cannabis and the Cosmic Crusaders* comic book are identical, other than change in the title on the cover page. Andrusiek Decl. ¶¶ 54-56, Exs. 22-23, 39 TTABVUE 12-13, 131-33, 136-39. This is insufficient to show a "series" of works and insufficient to show use of CAPTAN CANNABIS in a manner that functions as a trademark. See *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142-44 (TTAB 2011) (distribution of DVDs and videocassettes featuring the same content, with minor

differences, does not constitute a “series” of works). Thus, the Board should cancel the Registration because Respondent’s claimed CAPTAIN CANNABIS trademark fails to function as a mark.

C. **Respondent Has Not Used, Cannot Use, and Does Not Own the CAPTAIN CANNABIS Mark**

The Board should cancel the Registration because Respondent is a fictional entity that no longer exists, never used or acquired rights in the CAPTAIN CANNABIS mark (before application or otherwise), and has no capacity to use the CAPTAIN CANNABIS mark. A Registration should be cancelled where the Respondent did not engage in *bona fide* use prior to expiration of the time for filing a statement of use, and where the Respondent is not (and was not at the time of filing) the rightful owner of the registered mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1051-1055 (TTAB 2017) (lack of use prior to statement of use deadline); *Lyons v. American College of Veterinary Sports Medicine and Rehabilitation*, 859 F.3d 1023, 1027, 123 U.S.P.Q.2d 1024, (Fed. Cir. 2017) (“[R]egistration by one who did not own the mark at the time of filing renders the underlying application void ab initio.”); *Conolty v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302 (TTAB 2014). In this case, the Registration should be cancelled because Respondent never used and never owned the CAPTAIN CANNABIS mark.

Respondent was formed as a limited liability company under Florida law on March 19, 2014, and was dissolved by the State of Florida on September 25, 2015. Pet. Not. Reliance ¶ 10, Annx. 11, 12 TTABVUE 5, 51; Pet. Rebut. Not. Reliance ¶ 1, Ex. A p. 2, 37 TTABVUE 2, 7; Matesky Decl. ¶¶ 4-5, Exs. A-B, 39 TTABVUE 144-45, 147, 149; *cf. Live Entertainment, Inc. v. Digex, Inc.*, 300 F. Supp. 2d 1273, 1277 (S.D. Fla. 2003) (Relying on [www.sunbiz.org](http://www.sunbiz.org) to establish that corporation was dissolved). In other words, Respondent existed for only a year and a half.

The evidence shows that Respondent never used the CAPTAIN CANNABIS mark, and Respondent has provided no evidence to the contrary. Rather, Lewis Davidson testified that he began using the CAPTAIN CANNABIS trademark on comic books in 2013—before Respondent existed. Davidson Decl. ¶ 17, 17 TTABVUE 4. Mr. Davidson continues to claim that he personally uses and owns the CAPTAIN CANNABIS trademark. *See* Pet. Rebuttal Not. Reliance ¶ 2, Ex. B pp.1-2, 8, 37 TTABVUE 2-3, 10-11, 17. There is no evidence that Mr. Davidson ever assigned, exclusively licensed, or otherwise transferred any alleged trademark rights to Respondent. Where the evidence shows that any use was undertaken and controlled by individuals, and no rights or goodwill were assigned to an LLC, a registration in the LLC’s name must be cancelled. *See Conolty v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302 (TTAB 2014). In this case, Respondent’s own evidence and Mr. Davidson’s testimony show that Respondent did not use or own the CAPTAIN CANNABIS trademark at the time of application, and has no rights in the CAPTAIN CANNABIS mark.<sup>4</sup> Accordingly, the Registration is void ab initio and should be cancelled.

**D. Respondent Obtained the Registration Through Fraud on the PTO**

The Board should cancel the Registration because Respondent obtained the Registration through fraud. A registration should be cancelled where it was obtained through fraud. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *see also* TBMP § 309.03(c)(1)(cancellation is appropriate where the Respondent “committed fraud in the procurement of its registration.”). In order to support its fraud claim, petitioner must show by clear and

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<sup>4</sup> Even if Registrant had used the CAPTAIN CANNABIS mark or acquired rights thereto at some point (there is no evidence of this), Registrant lost its capacity to use the CAPTAIN CANNABIS mark when it was dissolved in 2015. Under the Florida Revised Limited Liability Company Act, an LLC “continues after dissolution only for the purpose of winding up.” Fl. Stat. § 605.0709(1) (2019).

convincing evidence that Respondent knowingly made a false, material representation of fact in connection with its application, with the intent of obtaining a registration to which it is otherwise not entitled. *See In re Bose*, 580 F.3d at 1243. The evidence clearly shows that Respondent, in order to improperly obtain the Registration, knowingly and falsely stated that **(1)** no other party had the right to use the CAPTAIN CANNABIS mark in connection with comic books, despite Respondent’s knowledge of Petitioner’s prior use and rights, and **(2)** that Respondent had used the CAPTAIN CANNABIS trademark on a “series” of comic books.

First, Petitioner falsely swore that no other person had the right to use the CAPTAIN CANNABIS trademark on comic books, despite actual knowledge of Petitioner’s rights. On May 13, 2013, Petitioner contacted Lewis Davidson to inform him of Petitioner’s use of and rights in the CAPTAIN CANNABIS trademark and to demand that Mr. Davidson stop using the CAPTAIN CANNABIS trademark in connection with a video distributed under the title “The Captain Cannabis Show.” *Andrusiek Aff.* ¶ 21, 11 TTABVUE 10. Mr. Davidson admitted that he only applied to register the CAPTAIN CANNABIS mark because he learned of Petitioner’s prior use of and rights in the CAPTAIN CANNABIS mark. *Pet. Not. Reliance* ¶¶ 5-6, *Annx. 6*, *Ex. A* at p.25, *Annx. 7* at p. 27, 12 TTABVUE 3-4, 26, 28. He did so in order to extort royalty payments from Petitioner based on Petitioner’s preexisting business. *Id.*

In carrying out this scheme, Mr. Davidson swore under penalty of perjury on that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause

confusion, or to cause mistake, or to deceive.” This was a lie, told solely to obtain a registration Respondent could not otherwise have obtained if Mr. Davidson had told the truth—of which he had actual knowledge—regarding Petitioner’s prior rights in and use of the CAPTAIN CANNABIS mark.

Second, Respondent falsely claimed to have distributed a series of comic book issues under the CAPTAIN CANNABIS mark for the express purpose of overcoming the examining attorney’s refusal based on failure to function as a mark. On December 29, 2014, Respondent submitted a specimen of use showing a comic book cover bearing the title *The Cosmic Crusaders – “Reboot”*. Statement of Use; Specimen. On February 6, 2015, the examining attorney rejected Respondent’s application on the grounds that the claimed CAPTAIN CANNABIS mark does not function as a trademark on the specimen submitted. Office Action Outgoing (“Sections 1, 2, and 45 Refusal—Mark Does Not Function As A Trademark”).

To overcome this rejection, Respondent submitted a substitute specimen showing the same comic book cover, but bearing the title *Captain Cannabis and the Cosmic Crusaders*. Resp. to Office Action p. 2. Respondent falsely identified this specimen as depicting “another issue in Applicant’s serialized comic book series under the mark CAPTAIN CANNABIS.” *Id.* p. 1. In reality, as discussed in Section IV(B), *supra*, Respondent never published a series of comic book issues. Rather, at most, Respondent published a single comic book issue occasionally bearing two alternative titles. The only reason Respondent falsely claimed that its substitute specimen represented “another issue in Applicant’s serialized comic book series” was to overcome the examining attorney’s “failure to function as a mark” refusal and to obtain a Registration that Respondent was not entitled to obtain. Accordingly, for these reasons, the Registration should be

cancelled for fraud on the PTO.

**V. CONCLUSION**

For the reasons discussed above, Petitioner respectfully requests that the Board grant his petition and cancel Registration No. 4,782,920 for the CAPTAIN CANNABIS word mark used on comic books.

DATED: October 12, 2020

Respectfully submitted:

MATESKY LAW<sup>PLLC</sup>

s/ Michael P. Matesky, II/

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Attorney for Petitioner

## **CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing on Respondent's counsel of record by email transmission to josephw@jpfirm.com, pattit@jpfirm.com, pursuant to Trademark Rule § 2.119(b), 37 C.F.R. § 2.119(b).

Dated: October 12, 2020

s/ Michael P. Matesky, II/  
Michael P. Matesky, II